

REMARKS/ARGUMENTS

Before entry of this Amendment and Response, claims 24-26 and 28-42 are pending and claims 31-38 stand withdrawn, as being drawn to a nonelected species. The status of the application is as follows:

- Claims 24 and 39 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement;
- Claims 24-26, 28-30, and 39-42 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- Claims 24, 25, 39, and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Teeney '092 ("Teeney");
- Claims 24, 25, 39, and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Foss *et al.* '799 ("Foss"); and
- Claims 24-26, 28-30, and 39-42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Speiser '473 ("Speiser").

Independent apparatus claim 24 and independent method claim 39 have been amended to define more particularly the tool holding device as being "freestanding" and specifically the static force relationship between the rails and the elongate member when inserted therebetween. The independent claims have also been amended to address the negative limitation.

To maintain consistency, correct dependencies, and conform the language of the dependent claims to the amended independent claims, dependent claims 25-26, 28, 33, 37, and 41-42 have been amended and dependent claims 34-36 and 40 have been canceled.

Claims 24-26, 28-33, 37-39, and 41-42 are currently pending and presented for reconsideration. In view of above amendments and following remarks, Applicant respectfully requests reconsideration and withdrawal of all grounds of rejections and allowance of claims 24-26, 28-33, 37-39, and 41-42, in due course.

1. Applicant's undersigned representative hereby appreciates the Examiner's courtesy in extending the telephonic interview in this application conducted on August 21, 2003, and appreciates the helpful suggestions made by the Examiner. The amendments and arguments made herein are consistent with the discussion in the interview.

2. Claims 24 and 39 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office action states that the specification does not support the use of the phrases "lacking means" and "without providing means" in the claims.

Applicant has amended claims 24 and 39 to replace the term "means" with the phrase "a base plate." No new matter has been entered thereby, support for the amendment being found, for example, in FIGS. 1-2, which depict the elected species. FIGS. 1-2 depict a tool holder 10 that includes rails 12a, 12b and end plates 18, but no base plate, such as the optional base plate 126 depicted in the non-elected species tool holder 110 of FIG. 4. See, also, the description of FIG. 4 and the optional base plate 126 in the specification at pg. 9, line 18, to pg. 10, line 2.

Accordingly, Applicant respectfully submits that the specification and the drawings fully support and enable a tool holder lacking or without the optional base plate. Reconsideration and withdrawal of the rejection of claims 24 and 39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement are respectfully requested.

3. Claims 24-26, 28-30, and 39-42 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office action states that the limitations "lacking any [sic] means for supporting the lower end of the elongate member when received between the rails" in independent claim 24 and "without providing means for supporting the lower end of the elongate member when received between said rails" in claim 39 appear to be vague or indefinite.

As stated above, Applicant has amended claims 24 and 39 to replace the term "means" with the phrase "a base plate." No new matter has been entered thereby, support for the

amendment being found, for example, in FIGS. 1-2, which depict the elected species. FIGS. 1-2 depict a tool holder 10 that includes rails 12a, 12b and end plates 18, but no base plate, such as the optional base plate 126 depicted in the non-elected species tool holder 110 of FIG. 4. See, also, the description of FIG. 4 and the optional base plate 126 in the specification at pg. 9, line 18, to pg. 10, line 2.

Accordingly, Applicant respectfully submits that the claims are clear and definite, being drawn to a tool holder lacking or without the optional base plate. Because independent claims 24 and 39 are definite, all claims depending therefrom are definite, as well. Claim 40 has been canceled. Reconsideration and withdrawal of the rejection of claims 24-26, 28-30, 39, and 41-42 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention are respectfully requested.

4. Claims 24, 25, 39, and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Teeney. Applicant respectfully traverses this rejection as applicable to the claims, as amended.

Briefly, Teeney appears to disclose a tool rack including main frame members 1, 2, legs 3, 4, arm segments 5, 6, and upper and lower racks 16, 17. The racks 16, 17, each include a pair of respective rails 18, 19 and a plurality of respective barriers 20, 21. A tool handle, H, is loosely retained in the rack in areas defined by the rails and barriers. See FIG. 1 of Teeney. Additionally, the rack is secured to wall studs by fasteners 12, 13 passing through an opening 11 formed by brackets 9, 10. An alternative embodiment rack, that retains tools based on the same principle, is depicted in FIG. 2. This rack also is secured to wall studs 45 by fasteners 43, 44 passing through an open area 42 formed by brackets 40, 41.

Applicant has amended independent claims 24 and 39 to more clearly define the structure of Applicant's dual rail tool holder and its principle of operation. Specifically, the independent claims have been amended to recite that the rails are "further characterized by generally opposed edges for simultaneously contacting and exerting reaction forces on the elongate member when inserted therebetween, to lodge and restrain the elongate member in a generally vertical and leaning orientation therebetween..." No new matter has been entered thereby, antecedent basis

of the amendment being found, for example, in the specification at pg. 8, lines 6-18, in FIG. 2, and in claim 25. See, also, the specification at pg. 7, line 19, to pg. 8, line 5, as well as page 11, lines 3-11. As discussed in detail, the arrangement of the rails (and the optional depressions in the opposed edges of the rails) prevents an elongate member from accidentally becoming dislodged from its resting position.

In accordance with Applicant's claimed invention, once an elongate member, such as a tool handle, is inserted between the rails and released, the tool leans, the opposed edges of the rails "simultaneously contacting and exerting reaction forces on the elongate member..." As recognized in the Office action, Applicant's invention is clearly distinguishable from the structure and principle of operation of the Teeney rack, in which "the edges do not contact the member at the same time." See the Office action beginning at pg. 3, last line.

Moreover, in accordance with Applicant's claimed invention, the rails "lodge and restrain" the handle. This is clearly unlike Teeney, where the handle is loosely maintained in an area bounded by the rails 18, 19 and barriers 20, 21 and is free to move thereabout, much in the same way a handle is disposed in a prior art barrel.

Still further, independent claims 24 and 39 have been amended to recite that the claimed tool holding device is "freestanding." No new matter has been entered thereby, antecedent basis for the amendment may be found, for example, in the application at pg. 3, lines 18-19. Both embodiments of the rack of Teeney depicted in FIGS. 1 and 2 include fasteners 12, 13, 43, 44 that are used to secure the racks to wall studs 45. Because of the configuration of the Teeney racks, like prior art barrels, it appears apparent that the racks are unstable when loaded with a tool and would tip, in the event the racks were not securely fastened to a stable structural elements, such as the wall studs 45. This is unlike Applicant's invention, which is inherently stable and does not require attachment to external structure, such as a wall. See, for example, Applicant's specification at pg. 4, lines 9-20.

For any of these reasons, Applicant respectfully submits that independent claims 24 and 39 are not anticipated by Teeney. Claim 25 includes all of the limitations of claim 24 and, therefor, is patentable as well. Claim 40 has been canceled. Accordingly, reconsideration and

withdrawal of the rejection of claims 24, 25, and 39 under 35 U.S.C. § 102(b) as being anticipated by Teeney are respectfully requested.

5. Claims 24, 25, 39, and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Foss. Applicant respectfully traverses this rejection as applicable to the claims, as amended.

Briefly, Foss appears to disclose a glue gun organizer. A wire structure 12 includes a metal base 10, two trapezoidal shaped members 14, 16, multiple cross braces members 20-26, and a U-shaped member 30 to receive a tip 35 of a glue gun 34. The organizer is also configured to hold two glue stick boxes 44, 46, and a tray 40 for extra parts or equipment. A J-shaped member 50 attaches the organizer to a wall with screws 52, 53.

Applicant's claimed dual rail tool holder invention may be distinguished from the glue gun organizer of Foss on at least two bases. First, and as stated above, Applicant has amended independent claims 24 and 39 to more clearly define the structure of Applicant's dual rail tool holder and its principle of operation to recite that the claimed tool holding device is "freestanding." Second, Applicant's tool holder, as claimed, is configured and adapted to receive "a lower end of an elongate member therein," such as a handle of a large garden tool.

More specifically, Foss utilizes the J-shaped member 50 to attach the organizer to the wall. Beginning at col. 2, line 66, Foss states:

Finally, FIG. 1 shows a J-shaped member 50 adapted for mounting the wire structure 12 and base 10 on a vertical surface such as a nearby wall with fastening means such as screws 52 and 53. A lower part of the "J" is made to fit around one of the cross braces such as 21, 22 or 23 and thus hold the structure elevated from the work surface for use in storage or, if convenient, while the glue gun work is being performed.

As can be seen in FIG. 3 of Foss, the organizer is adapted to receive only a tip 35 of a glue gun 34. Given the relative size of the tip 35 and the organizer, it appears clear that the organizer is only a few inches in height H, length L, and width W. Moreover, only the tip 34 of the glue gun 35 is received in the organizer. The remainder of the glue gun 34, such as a conventional trigger switch, pistol grip handle, electrical cord, etc. extends in an overhanging or cantilevered arrangement, well beyond the perimeter of the organizer. While Foss goes on to state, at col. 3, lines 6-11. that the organizer "will not tip over when in use," it appears that the

cantilevered arrangement is, in fact, unstable; thus, the need for the J-shaped member 50 to attach the organizer firmly to the wall. While apparently an improvement over the prior art, the Foss glue gun organizer is simply an improvement over highly unstable prior art holders. As discussed in the Background, Foss states, at col.1, lines 11-25:

In the past, glue guns have been provided with small plastic or metal attachments usually in the form of a upright member extending from a tripod arrangement or flat based arrangement against which the tip of a hot glue gun can be rested to prevent it from falling onto the table or surrounding equipment. Difficulties have been encountered with the prior art devices due to constant picking up and laying down of the glue gun or the force that may be exerted on the gun due to a trailing electric cord or a little carelessness, on the part of the operator with the result that the glue gun may not always be rested accurately and the tripod or other holder arrangement falls over allowing the hot glue gun to come in contact with other surfaces and possibly burn or otherwise mar them.

Accordingly, when read in the context of the prior art tripods and supports described in Foss, while the Foss organizer may be an improvement, the organizer is not inherently stable in use and requires attachment to a wall using the J-shaped member 50 to prevent tipping. Accordingly, the Foss organizer should not be considered “freestanding” in use, due to the small size of the organizer relative to the glue gun 34 and the cantilevered, overhanging arrangement of the majority of the glue gun 34, when the tip 35 is received in the organizer. This is unlike Applicant’s invention, which is inherently stable and does not require attachment to external structure, such as a wall. See, for example, Applicant’s specification at pg. 4, lines 9-20.

Moreover, Applicant’s claimed tool holder device is adapted to receive therein the lower ends of relatively large, elongate (i.e., slender) members, such as the handles of garden tools (e.g., rakes, shovels, brooms, etc.), hockey sticks, fishing poles, pool maintenance equipment, and the like. See Applicant’s specification at pg. 1, lines 10-11, pg. 6, lines 12-15, and FIGS. 1-2. These elongate members are readily distinguishable from the small, conical tip 35 of the glue gun 34 received in the organizer of Foss.

For any of these reasons, Applicant respectfully submits that independent claims 24 and 39 are not anticipated by Foss. Claim 25 includes all of the limitations of claim 24 and, therefore, is patentable as well. Claim 40 has been canceled. Accordingly, reconsideration and withdrawal

of the rejection of claims 24, 25, and 39 under 35 U.S.C. § 102(b) as being anticipated by Foss are respectfully requested.

6. Claims 24-26, 28-30, and 39-42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Speiser. Applicant respectfully traverses this rejection as applicable to the claims, as amended.

Briefly, Speiser appears to disclose a broom rack including end standards A, A', bottom or base shelf B, second shelf C, third shelf D, and upper shelf E. Inverted top brooms hang from notches e in top shelf E, their handles passing through slots d in third shelf D. The other brooms lean in aligned notches c and d in shelves C and D, respectively, or hang from screw eyes d² and rest in shallow sockets c in shelf C.

Independent claims 24 and 39 are drawn to Applicant's dual rail tool holder and its principle of operation. Specifically, the independent claims recite that the rails are "further characterized by generally opposed edges for simultaneously contacting and exerting reaction forces on the elongate member when inserted therebetween, to lodge and restrain the elongate member in a generally vertical and leaning orientation therebetween..." In accordance with Applicant's claimed invention, once an elongate member, such as a tool handle, is inserted between the rails and released, the tool leans, the opposed edges of the rails "simultaneously contacting and exerting reaction forces on the elongate member..."

Applicant's invention is clearly distinguishable from the structure and principle of operation of the Speiser broom rack, in which the brooms are either hung or lean in aligned notches. The structure and operation of Speiser is clearly unlike that of Applicant's claimed invention, in which a pair of rails "lodge and restrain" the handle.

For any of these reasons, Applicant respectfully submits that independent claims 24 and 39 are not anticipated by Speiser. Dependent claims 25-26 and 28-30 include all of the limitations of claim 24 and dependent claims 41-42 include all of the limitations of claim 39; therefore, these claims are patentable as well. Claim 40 has been canceled. Accordingly, reconsideration and withdrawal of the rejection of claims 24-26, 28-30, 39 and 41-42 under 35 U.S.C. § 102(b) as being anticipated by Speiser are respectfully requested.

7. As mentioned above, dependent claims 25-26, 28, 33 (withdrawn), 37 (withdrawn), and 41-42 have been amended and dependent claims 34-36 (withdrawn) and 40 have been canceled, to maintain consistency, correct dependencies, and conform the language of the dependent claims to the amended independent claims. No new matter has been added.

For example, claims 28 and 42 have been amended to define that depressions are formed in the opposed edges of the rails "to further restrain" the elongate member, when received in the tool holder. Antecedent basis may be found, for example, in the specification at pg. 14, lines 10-11, and at pg. 15, lines 7-8.

Note that Applicant has amended withdrawn claims 33 and 37 and canceled withdrawn claims 34-36 in accordance with proper species restriction practice, so that upon allowance of generic claim 24, all withdrawn claims will be in proper form for allowance, as well.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration, withdrawal of all grounds of rejection, and allowance of claims 24-26, 28-33, 37-39, and 41-42 in due course. The Examiner is invited to contact Applicant's undersigned representative by telephone at the number listed below to discuss any outstanding issues.

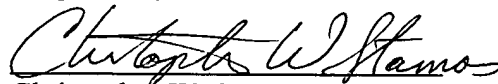
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